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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,132	02/16/2005	Jean-Michel Lagrange	FR 020088	1955

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BRIARCLIFF MANOR, NY 10510

EXAMINER

MACKOWEY, ANTHONY M

ART UNIT	PAPER NUMBER
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2624

MAIL DATE	DELIVERY MODE
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09/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/525,132</p>	<p>Applicant(s) LAGRANGE ET AL.</p>	
	<p>Examiner ANTHONY MACKOWEY</p>	<p>Art Unit 2624</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-4.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Matthew C Bella/
Supervisory Patent Examiner, Art Unit 2624

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed July 29, 2008, with respect to the claim rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. The rejection of claims 1-4 under 35 U.S.C. 103 was proper and should be maintained.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant argues the combination of the references is "hindsight" because an "express" suggestion or motivation to combine the references is lacking. However, there is no requirement that an "express", written suggestion or motivation to combine must appear in prior art references before a finding of obviousness." See *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004). While a suggestion or motivation to combine references is an appropriate method for determining obviousness, it is just one of a number of valid rationales for doing so. The Court in *KSR* identified several exemplary rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham*. See *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1395-97 (2007). See MPEP 2143.

Applicant's submits the combination of references is improper because "the total and complete silence on the applicability of the teachings of Murthy, et al. to any other imaging technology may suggest that for reasons undisclosed in the reference, the teachings are not usefully applied to other than x-ray imaging." Murthy's silence with regard to the technique's application beyond x-ray imaging is neither a teaching away from the technique's use in combining other types of images (e.g. ultrasonic images), nor sufficient evidence showing there was no reasonable expectation of success or that the results of applying Murthy image processing technique would not yield predictable results. Applicant has not provided any additional evidence showing there was no reasonable expectation of success that may support a conclusion of nonobviousness. Furthermore, "A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton." *KSR*, 82 USPQ2d at 1397. "[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* Office personnel may also take into account "the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* 82 USPQ2d at 1396. See MPEP 2141. One of ordinary skill in the art at the time the invention was made would have had sufficient skill and creativity to modify the image combining method taught by Murthy to be applicable to combine ultrasound images with a reasonable expectation of success. In the Final Office Action (page 5), the examiner presented "substantially improved accuracy and efficiency of image compositing" as the predictable result of combining the teachings of Murthy and Entrekin such that the method for combining images taught by Murthy be used to combine ultrasonic images. However, one of ordinary skill in the art at the time the invention was made would have also identified this as a benefit provided by Murthy's method and therefore, a motivation for its application to other imaging modalities for which a combined image may be desired. As such, the combination of Murthy et al. and Entrekin et al. presented in the rejection of the claims under 35 U.S.C. 103 in the Final Office Action was not improper.

Further arguments regard claim 1 are directed toward Murthy et al. as failing to disclose at least one feature of (pages 8-9, section c). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As clearly articulated in the Final Office Action, Entrekin et al. was cited as teaching ultrasonic images to be combined. Therefore, the combination of Murthy et al. and Entrekin et al. presented in the rejection of the claims under 35 U.S.C. 103 in the Final Office Action was not deficient in disclosing or suggesting all the features of claim 1.

Applicant has provided no further arguments with regard to claims 2-4 beyond their dependence from claim 1.